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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/479,979	01/10/2000	WILLIAM HILL	13237-1701/M	3757

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EXAMINER

HUYNH, CONG LAC T

ART UNIT PAPER NUMBER

2178

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/479,979

Applicant(s)

HILL ET AL.

Examiner

Cong-Lac Huynh

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: amendment filed 10/15/04 to the application filed on 01/10/00 which is a continuation of the application 08/847,427 filed on 4/24/97, now US Pat No. 6,023,714.

2. Claims 35-53 are pending in the case. Claims 35, 42, and 38 are the independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103 (c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 2178

5. Claims 35-53 remain rejected under 35 U.S.C. 103(a) as being unpatentable Guck (US Pat No. 5,911,776, 6/15/99, filed 12/18/96) in view of DeRose et al. (US Pat No. 5,557,722, 9/17/96, filed 4/7/95).

Regarding independent claim 35, Guck discloses:

- Interrogating the output device to determine a set of capabilities of the output device (**abstract:** *automatically reformatting the style of the source document to match the requirements of the receiver's appliances*, which are equivalent to the output devices, inherently shows that the capabilities of the receiver's appliances are identified via a checking process to determine said capabilities as the requirements to reformat the style of the source document; in other words, checking the receiver's appliances to identify and determine the capabilities of the receiver's appliances implies said interrogating; **col 4, line 41 to col 5, line 25:** the fact that a user or author who creates a single file, can then access multiple ones of the shadow files and converter sets in order to provide multiple outputs in a format which can be made available to various types of receiving appliances indicates that the capabilities of a receiving appliance, which is equivalent to the output device, are identified via a checking process to determine said capabilities before creating a shadow file and before sending the source document with a required format matched the capabilities of the receiver's appliances)

- selecting one format from multiple available formats based on the set of capabilities of the output device determined by interrogating the output device (**figure 3, step C**: “author selects one format from multiple available formats”; **col 16, lines 13-60**: “At step C, the author selects one format from the multiple number of available formats .. marks *the file as shadow file which selects the source file...* at step F, the system can display a list of *available converters based on the source/shadow MIME types* and at step G, the author or a User can select a particular converter... At step I, *the shadow file fetches the content of its source file* and then at step J, calls on the transformation function of its converter, where at step K *the converter transforms the input content into an output content ...*”; the fact that the format is selected from a plurality of formats where the transformation of the formats is controlled by the converter to provide the format of the requester client, where the format is determined via checking the capabilities of the receiver’s appliances shows selecting one format from multiple available formats based on the capabilities of the output device determined by interrogating the output device)
- formatting the document for presentation on the output device (**abstract**: a client and a user of the network can access and receive a copy of the original source document which is automatically reformatted to match the requirements of the receiver’s appliances; **col 4, line 66 to col 5, line 24, col 8, lines 1-29**: providing multiple outputs in a format which can be available to various types of receiving

appliances indicates that the output document is formatted according to the specified type of the receiving appliance, which is the output device)

Guck does not explicitly disclose that the formats for a document are the style sheets.

DeRose discloses that a style sheet includes format characteristics for type names of elements in a document and a document is also provided with one or more style sheets for specifying format characteristics for its display (col 3, lines 28-50).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined DeRose into Guck for the following reason.

DeRose indicates that the format characteristics of the elements in a document are equivalent to the style sheets of the elements in a document providing the advantage to incorporate into Guck to select a style sheet from a plurality of style sheets based upon the capabilities of the output device since selecting the format characteristics is considered equivalent to selecting style sheets.

Regarding claim 36, which is dependent on claim 35, Guck and DeRose do not disclose explicitly that a layout generator is used for interrogating the output device to determine a set of the capabilities of the output device and selecting one of a plurality of style sheets based upon the set of capabilities of the output device.

However, Guck does teach determining a set of the capabilities of the output device and selecting one format from a plurality of available formats where these formats are suitable to the receiving appliances (as mentioned in claim 35). DeRose discloses that

Art Unit: 2178

the style sheets includes format characteristics of the elements of a document (as mentioned in claim 35).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined DeRose into Guck since DeRose discloses that the style sheets are merely the format characteristics of the elements in a document providing the advantage to incorporate into Guck for selecting a style sheet from a plurality style sheets based on the capabilities of the output device to format a document according to capabilities of the output device determined via checking the capabilities of the output device.

Regarding claims 37, 44-45, 50, which are dependent on claims 35, 42, 48, respectively, Guck and DeRose do not disclose that the layout generator is external to the document.

Instead, Guck discloses that the shadow file and the converter for controlling the format of the document based on the device of the requester client are separate from the content of the source file (col 4, lines 40-54, 66 to col 5, line 24, col 8, lines 19-29).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Guck to include the layout generator external to the document since the fact that the shadow file and the converter for controlling the format of the output document is separate from the content file suggests that the shadow file and converter in Guck which are considered equivalent to the layout generator, be *external to the document*.

Regarding claims 38-41, 46-47, 49-52, which are dependent on claims 35, 42, 48, respectively, Guck does not disclose embedding the style sheet in the document, placing a style tag corresponding to the selected style sheet in the document, wherein the document includes a plurality of tags and embedding the selected style sheet comprises placing style attributes corresponding to the selected style sheet in the tags of the document.

DeRose discloses formatting an electronic document by including the style sheets in the markup elements i.e. the tags (col 3, line 57 to col 4, line 11, col 15, line 64 to col 16, line 67).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined DeRose into Guck for the following reason. The fact that DeRose discloses formatting a markup document using style sheets suggests embedding style sheets in the markup tags since it was well known that a markup document is written using tags for including format characteristics to the elements in the markup document. Accordingly, it is suggested that the style sheets selected for the document to be delivered to an output device be embedded in the tags of the markup language document.

Independent claim 42 includes limitations of claim 35, and is rejected under the same rationale except the limitations: selecting *a layout generator* and generating the selected style sheet based upon the set of capabilities of the output device *using the layout generator*.

Art Unit: 2178

Guck discloses reformatting the content of the source file into a format that matches the capabilities of the requesting device (col 4, lines 41-54, 66 to col 5, line 24, col 8, lines 19-29, col 16, lines 13-60).

DeRose discloses formatting a markup document using style sheets (col 15, line 64 to col 16, line 59, col 3, line 12 to col 4, line 30).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined DeRose into Guck since DeRose discloses that style sheets includes format characteristics for formatting the elements of a document providing the advantage to incorporate into Guck for utilizing the style sheets as format characteristics for reformatting a document to a format that matches the capabilities of receiving appliance which is equivalent to the output device.

Regarding claim 43, which is dependent on claim 42, Guck discloses that the layout generator is a general purpose layout generator for use with a plurality of documents (col 4, lines 40-54, 66 to col 5, line 24: the converter is for reformatting the content of the source file of a plurality of documents according to the request of the client, the converter, thus, is considered equivalent to a layout generator for use with a plurality of documents).

Regarding independent claim 48, the claim includes the limitations as in claims 35 and 42 except interrogating the output device to determine a set of capabilities of the output device. It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to have modified Guck and DeRose to add interrogating the output device to determine a set of capabilities of the output device since said interrogating is inherently included in "determining a set of capabilities of the output device" which is mentioned in claim 35. The reason is that the system should question the output device to find out the capabilities the output device has.

Regarding claim 53, Guck and DeRose disclose that the document is a markup language document (Guck: col 6, lines 10-22, col 4, lines 17-31; DeRose: col 3, lines 12-50, col 8, line 39 to col 9, line 20).

Response to Arguments

6. Applicant's arguments filed 10/15/04 have been fully considered but they are not persuasive.

Applicants argue that Guck in no way interrogates an output device to determine a set of capabilities of the output device or selects a format based on the set of capabilities of the output device determined by interrogating the output device. Applicants state that when creating the desired shadow file, no output device has been identified much less interrogated; moreover, when the output device has been identified, the requestor or client calls for the desired output content in a particular format where the required conversion parameters have already established when the output device is ultimately identified (Remarks, page 6).

Examiner respectfully disagrees.

Art Unit: 2178

In Guck, the shadow file is created for including the format of the source document corresponding each type of receiver's appliances, which are equivalent to the output devices (abstract, col 4, lines 41-54, col 16, lines 45-60). As admitted by Applicants, the required conversion parameters *have already established when the output device is ultimately identified* for providing a suitable format to a user's request. This implies that the output devices as well as their capabilities are identified in advance by checking each type of the output devices for determining their capabilities. In other words, said identifying the output devices further implies interrogating the output devices for their capabilities for creating the shadow files, which include the formats, for the source document.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2178

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Noy (US Pat No. 5,519,852, 5/21/96, filed 10/25/94).

Miller et al. (US Pat No. 6,257,693 B1, 7/10/01, filed 4/10/97).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 703-305-0432. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 703-308-5465. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Clh
1/24/05


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